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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,251	11/16/2000	Margaret Gardner MacPhail	AUS9-2000-0470-US1	4095

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EXAMINER

HOANG, PHUONG N

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,251

Applicant(s)

MACPHAIL, MARGARET
GARDNER

Examiner

Phuong N. Hoang

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 5, 7 - 12, 14 - 18, and 20 - 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 5, 7 - 12, 14 - 18, and 20 - 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 5, 7 – 12, 14 – 18, and 20 - 48 are pending for examination.
2. The cross reference related to the application cited in the specification must be updated (i.e. update the relevant status, with PTO serial numbers or patent numbers where appropriate, on page 1, lines 4 – 15; the entire specification should be so revised).
3. Claims 14 and 20 are objected to under 37 CFR 1.75(c) as being in improper form because more than one claim may be represented provided they differ substantially from each other and are not unduly multiplied (claims 14 and 20 did not further limit from claims 8 and 15). See MPEP § 608.01(i). Accordingly, the claims 14 and 20 had not been further treated on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 – 5, 7 – 12, 14 – 18, and 20 – 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack proper antecedent basis:

- i. the system event and the problem - claim 21;
- ii. the additional actions and the action diaries - claim 22;
- iii. the action diaries - claim 34;
- iv. the archived approaches - claims 36, 37, and 38;
- v. the archival rules - claim 38;
- vi. the approach group and the first approach group - claim 42;

b. The claim language in the following claims is not clearly understood:

- i. As per claim 1, lines 4 - 5, it is not clearly indicated from whom the second operator received the first actions (i.e., it is from the first operator or from the action diary when the second operator using the action diary); lines 7 - 9, it is uncertain what the relationship is between the first actions and the comments received and how the comments was stored in the action diary (i.e., are the comments related to the first actions and they are stored corresponding to the first action.).
- ii. As per claims 3, 10, and 17, line 3, it is not clearly indicated what "the stored actions" included (i.e., it is all the stored actions, including the

first, second, and the combined actions or just the first or second or the combined actions.).

iii. As per claims 7 and 14, and 20, lines 4 - 5, it is not clearly indicated that searching "a data store for the action diary" means (i.e., is it searching the received system event in the action diary.).

iv. As per claim 8, lines 18 - 20, it is not clearly indicated that searching "a data store for the action diary" means (i.e., is it searching the received system event in the action diary.).

v. As per claim 15, line 13, it is not clearly indicated that searching "a data store for the action diary" means (i.e., is it searching the received system event in the action diary.).

vi. As per claims 22 and 23, lines 3 - 4, it is not clearly indicated what "the actions" included (i.e., it is all the stored actions, including the first, second, and the combined actions or just the first or second or the combined actions.); lines 5 - 7, it is not clearly indicated what "the action diaries" means (i.e. are there many action diaries.).

vii. As per claim 24, lines 4, it is not clearly indicated what "receiving action diary component data from the user" means.

viii. As per claims 25 and 31, lines 3 - 4, it is not clearly indicated what

"in response to the searching not identifying at least one action diary"
means.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 - 20 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 20 of copending Application No. 09,714,252 because the claims of the application 09,714,252 are about the receiving the system network events, creating a data capture object adapted to capture the data, searching for action diary, and storing action diaries, while the independent claims of the application 09/714,251 are about capturing the actions by the operators, editing one or more actions, searching for the action diary, and storing

Art Unit: 2126

the captured data. It would have been obvious to have operators to capture and process the events or actions because it is necessary to control and maintain the systems.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1 – 20 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 20 of copending Application No. 09,714,250 because the claims of the application 09,714,250 are about the action of receiving system events, searching for action diary, and creating storage for storing action diaries, while the claims of the application 09/714,251 are about capturing the actions by the operators, receiving one or more actions, searching for the action diary, and storing the captured data. It would have been obvious to create a storage for storing action diaries because it maintains data and data integrity.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2126

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toomey, US patent 6,119,147.**

5. **As to claim 1, Toomey teaches a method for coordinating efforts of a plurality of system operators, the method comprising the steps of:**

capturing one or more actions (captured meeting events, col. 2 lines 60 – 65, col. 5 lines 15 – 20, and col. 6 lines 5 – 15) taken by a first operator (one of the users at the meeting, col. 5 lines 15 – 24) in an action diary (document 105, col. 5 lines 15 - 45);

receiving the actions by a second operator (another user at the meeting are connected to the document 105 to see the displayed actions, col. 5 lines 15 – 25) using the action diary;

capturing one or more comments (users may inserts into Playbacks, col. 3 lines 2 – 9) from at least one of the operators; and

storing the captured comments in the action diary (record or store, col. 5 lines 20).

Toomey does not explicitly teach the actions including the first actions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that there should have at least first actions taking place when the meeting starts so users can interact with each other.

6. **As to claims 2 and 3, Toomey teaches the step of:**

combining one or more second actions or comments taken by the second operator with the first actions (col. 11 lines 30 - 40);

editing the stored actions, the editing resulting in a best current practice (col. 12 lines 40 - 60);

storing the combined actions or the best current practice (record or store, col. 5 lines 20).

7. **Claims 7 - 10, 14 - 17, and 20 - 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toomey, US patent 6,119,147 in view of Ferguson, US patent no. 6,304,861, and further in view of Douik, US patent no. 6,012,152.**

8. **As to claim 8, it is the system claim of claim 1. See rejection for claim 1 above.** Toomey also teaches the steps of a tool for coordinating operator (user interfaces and displays 120, col. 5 lines 145 - 55).

Toomey does not explicitly teach the steps of receiving data regarding a system event; searching a data store for the action diary, wherein the action diary corresponds to the received system event.

Ferguson teaches the steps of receiving data (network users receive problem, col. 5 lines 25 - 60); searching a data in a store (searching in the notebook icon for a match proposal, col. 7 lines 25 - 55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Toomey and Ferguson's system because Ferguson's searching for a problem would provide a time saving for solving the problem in the collaborative environment.

Toomey and Ferguson do not explicitly teaches the data regarding the network event.

Douik teaches the problem received regarding the network event (network faults, col. 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Toomey, Ferguson, and Douik's system because Douik's network event data would provide a problem solving that happens very often in the network environment.

9. **As to claims 9 and 10**, see rejection for claims 2 and 3 above.

10. **As to claims 7 and 14**, Toomey modified by Ferguson and Douik teaches the steps comprising of:

receiving data regarding a system event (Douik; network fault, col. 14);

searching a data store for the action diary (Ferguson; searching in the notebook icon for a match proposal (col. 7 lines 25 – 55), wherein the action diary corresponds to the received system event.

11. **As to claim 15**, it is the product claim of claim 8. See rejection for claim 8 above.
12. **As to claim 16 and 17**, see rejection for claims 2 and 3 above.
13. **As to claim 20**, see rejection for claim 7 above.
14. **As to claim 21**, Toomey modified by Ferguson and Douik teaches the steps of searching a data store for the action diary (Ferguson; searching in the notebook icon for a match proposal, col. 7 lines 25 – 55); performing one or more actions adapted to address the problem (Ferguson; the users revise and submit update proposal, col. 7 lines 40 – 55) related to the network device (Douik; network faults, col. 14 lines 15 – 50).
15. **As to claims 22 – 27**, Toomey teaches the step of
capturing one or more additional actions executed during the performance of the actions (Toomey; users may inserts into Playbacks, col. 3 lines 2 – 9);
modifying at least one of the action diaries by including the additional actions (Toomey; add remarks, col. 12 lines 30 - 45);
storing the modified action diaries (record or store, col. 5 lines 20);
displaying action diary information to a user (Toomey; display to the user in the meeting, col. 5 lines 15 – 45 and col. 7 lines 40 - 45);

receiving action diary component data from the user (Toomey; col. 5 lines 35 - 60);

creating a data capture object adapted to capture the data (Toomey; col. 5 lines 45 - 55);

creating a new action diary (Toomey; create new document, col. 13 lines 8 – 19), the new action diary including the new actions and at least one association resulting from the associating;

storing the new action diary (Toomey; every document should be saved, col. 6 lines 5 - 20).

16. **As to claim 28**, Ferguson teaches the step of performing one or more data capture actions in response to successful search for the action diary (col. 7 lines 25 - 40).

17. **As to claim 29**, Toomey modified by Ferguson teaches the steps of identifying data within a computer (Ferguson; col.7 lines 25 - 40); creating a method for automatically capturing the data (Toomey; col. 25 – 55);

18. **As to claim 30**, Douik teaches the steps of creating a storage method for storing the captured data (rules, col. 20 lines 5 - 22), and associating the storage method with one or more action diaries.

19. **As to claim 31**, Ferguson teaches the steps of identifying, creating, and associating are performed in the response to the searching not identifying at least one action diary (col. 7 lines 25 - 55).

20. **As to claims 32 and 33**, Toomey teaches the steps of creating a new action diary (Toomey; create new document, col. 13 lines 8 – 19), the new action diary including the new actions and at least one association resulting from the associating; storing the new action diary (Toomey; every document should be saved, col. 6 lines 5 - 20).

21. **As to claim 34**, Ferguson teaches the steps of performing one or more actions (col. 7 lines 25 – 55), wherein the one or more actions are identified by the action diaries.

22. **As to claims 35 and 38**, Toomey modified by Ferguson and Douik teaches the steps of locating one or more event solving approaches within the action diary (Ferguson; col. 7 lines 25 – 55); comparing the approaches with one or more archival rules (Douik; rules for storing data, col. 20 lines 5 - 22); archiving one or more of the approaches in response to the comparing (Ferguson; col. 7 lines 25 – 55).

23. **As to claim 36**, it would have been obvious to one of ordinary skill in the art to recognize that data can be added or removed to keep the store updated.

24. **As to claim 37**, it would have been obvious to one of ordinary skill in the art to recognize that storing the archived approaches in an alternate data store is very common to keep additional copy to prevent the disaster.

25. **As to claim 39**, Ferguson teaches the steps of
determining whether multiple approaches exist within the action diary (col. 7 lines 32 – 35); wherein the archiving is performed in response to determining that multiple approaches exist.

26. **As to claim 40**, Ferguson teaches the steps of
identifying a plurality of action diaries within an action diary data store (col. 7 lines 25 - 35); and
performing the locating, comparing, and archiving for each of the identified action diaries (col. 25 - 55).

27. **As to claim 41**, Ferguson teaches the step of manually selecting one or more approaches included in an action diary; and archiving the manually selected approaches (col. 7 lines 25 – 55).

28. **As to claims 42 and 43**, Ferguson teaches the steps of:
grouping action diaries (col. 7 lines 25 - 55), the grouping including:
including one or more objects (statements) in an approach group, wherein the
first approach or second group includes a first approach or second approach for
handling a system event;
storing the approach group in the action diary (stored in notebook, col. 7 lines 50
- 55).
29. **As to claims 44 and 45**, Toomey teaches the steps of:
displaying a first graphic related to the approach group, wherein the graphic
indicates a position of the approach group within a lifecycle (user interface or display,
col. 5 lines 14 - 30).
30. **As to claim 46**, Ferguson teaches the steps of the application built on object-
oriented method (Java (col. 4 lines 48 - 60), one of ordinary skill in the art can
recognize that the first approach group should include at least one of group properties,
action objects, text notes objects, and parameter objects.
31. **As to claim 47**, Toomey teaches the step of wherein the text notes objects
includes one or more annotations, the annotations (annotation, col. 13 lines 7 - 10)
describing handling the system event.

Art Unit: 2126

32. As to claim 48, Ferguson teaches the steps of displaying one or more objects included in the approach group (statements, col. 7 lines 25 - 55); selecting one of the objects, the selecting performed by an operator using a selecting device (network user selects one statement from the notebook, col. 7 lines 34 - 55); and modifying the selected object in response to the selecting (update or modify that proposal, col. 7 lines 40 - 45).

33. Claims 4 - 5, 11 - 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toomey, US patent 6,119,147 in view of Ferguson, US patent no. 6,304,861, and further in view of Douik, US patent no. 6,012,152, and further in view of Ozzie, US patent no. 6,640,241.

34. As to claim 4, 11, 18, Toomey, Ferguson, and Douik do not explicitly teach invoking a chat window, wherein the chat window includes displaying interactive information between the first and second operators. However, Toomey teaches the first and second operators interact with each other using GUI (col. 5 lines 15 - 25).

Ozzie teaches invoking a chat window on a first computer operated by the first operator and on a second computer operated by the second operator (chat system, col. 3 lines 60 - 65), wherein the chat window includes displaying interactive information between the first and second operators.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Toomey, Ferguson, Douik, and Ozzie's system because Ozzie's chat system would provide a user-friendly style to interactive information between human operators.

35. As to claims 5 and 12, Toomey modified by Ozzie teaches the steps of wherein the invoking automatically occurs when the first and second operators access the action diary (col. 5 lines 15 – 25).

Response to Arguments

36. Applicant's arguments filed on 3/11/04 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong N. Hoang whose telephone number is (703) 605-4239. The examiner can normally be reached on Monday - Friday 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ph
May 14, 2004


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